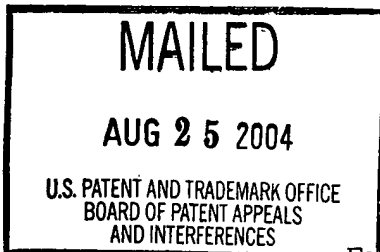


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 22



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte ERIC C. ANDERSON and PAUL S. CHAMBERS

Appeal No. 2003-1175  
Application No. 09/342,680<sup>1</sup>

ON BRIEF

Before HAIRSTON, LEVY, and SAADAT, Administrative Patent Judges.  
SAADAT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the Examiner's final rejection of claims 1-20, which are all of the claims pending in this application.

We affirm-in-part.

BACKGROUND

Appellants' invention is directed to a method and a system for viewing images from an image capture device, such as a

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<sup>1</sup> Application for patent filed June 29, 1999, which, according to Appellants, is a continuation-in-part of Application No. 09/059,611, filed April 13, 1998, now U.S. Patent No. 6,223,190.

digital camera, on a host computer without having to load device-specific software onto the host. According to Appellants, the conventional method of viewing images has the disadvantage of requiring a communication application that has been specifically written to communicate with that particular type of digital camera (specification, page 2). Appellants' invention overcomes the need for loading camera-specific communication software onto the host computer by automatically generating an Internet page description file in the camera which is used to reference and access the images (specification, page 4). The viewing of the images stored in the digital camera is done by accessing the Internet page description file through a standard web browser on the host computer (id.).

Representative independent claims 1 and 13 are reproduced below:

1. A method for viewing images from an image capture device on a host computer, comprising steps of:
  - a) establishing communication between the image capture device and the host computer;
  - b) automatically generating an Internet page description file in the image capture device that references the images stored therein;
  - c). mounting the image capture device as a disk on the host computer; and

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d) opening the Internet page description file in a web browser on the host computer, wherein the images stored in the image capture device are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.

13. A computer-readable medium containing program instructions for viewing images from a digital camera on a host computer, the program instructions for:

a) automatically generating an HTML file that references the images stored in the digital camera;

b) establishing a Universal Serial Bus (USB) connection between the digital camera and the host computer; and

c) identifying the digital camera to the host computer as a mass storage device class whereby the digital camera appears to the host computer as a disk, thereby allowing a user to open the HTML file in a web browser on the host computer, wherein the images stored in the digital camera are displayed on the host computer through the web browser without the need for loading camera-specific communication software onto the host computer.

The Examiner relies on the following references in rejecting the claims:

Cohen et al. (Cohen)	5,805,829	Sep. 8, 1998
Xu	5,848,420	Dec. 8, 1998
Narayan et al. (Narayan)	6,035,323	Mar. 7, 2000
		(filed Oct. 24, 1997)
Wang et al. (Wang)	6,058,428	May 2, 2000
		(filed Dec. 5, 1997)

Claims 1, 8 and 11-13 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Xu in view of Narayan.

Claims 2-5, 9, 10 and 14-18 stand rejected under 35 U.S.C.

§ 103(a) as being unpatentable over Xu, Narayan and further in view of Cohen.

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Claims 6, 7, 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Xu, Narayen and further in view of Wang.

We make reference to the answer (Paper No. 20, mailed December 17, 2002) for the Examiner's reasoning, and to the appeal brief (Paper No. 19, filed October 11, 2002) for Appellants' arguments thereagainst.

#### OPINION

At the outset, we note that Appellants indicate their intention that claims 1-7 stand or fall together, claims 8-12 stand or fall together and claims 13-20 stand or fall together (brief, page 4). However, Appellants have not, in the arguments section of the brief, provided separate arguments according to this grouping, as required by 37 CFR § 1.192(c)(7) (July 1, 2000). Therefore, we will consider Appellants' claims grouped as they are argued separately within these groups and as they correspond to each ground of rejection.

With respect to the rejection of claims 1, 8 and 13 over Xu and Narayen, Appellants acknowledge that Xu discloses a digital camera coupled to a personal computer which requires loading a software program to make the camera memory appear as a disk (brief, page 5). Appellants also assert that Narayen downloads

images from the digital camera into the computer before converting them into a web-viewable format (brief, pages 6 and 10-12). Appellants, however, argue that the combination of the references would result in a camera coupled to a computer wherein a software program is still loaded onto the computer for accessing the images stored in the camera and creating an album (brief, page 7). Additionally, Appellants indicate that the claims provide for viewing the images on the host computer "without the need for loading camera-specific communication software onto the host computer," whereas without the software, the computer in Xu is not capable of communicating with the digital camera as a disk (brief, page 8) and the web-viewable pages of Narayan are not generated in the camera (brief, page 12).

In response, the Examiner appears to rely on the "Web authoring" software in Narayan, which is not a device-specific or a camera-specific software, for asserting that the claimed steps a) to d) are performed without having to load a camera-specific software (answer, page 9). The Examiner further points out that the step of generating an Internet page description file, specially in claims 1 and 13, does not necessarily occur in the camera and therefore, reads on Narayan (answer, pages 9 & 10).

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As a general proposition, in rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993) and In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). A prima facie case of obviousness is established when the teachings of the prior art itself would appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Bell, 991 F.2d 781, 783, 26 USPQ2d 1529, 1531 (Fed. Cir. 1993); In re Fritch, 972 F.2d 1260, 1266 n.14, 23 USPQ2d 1780, 1783-84 n.14 (Fed. Cir. 1992); Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985). In considering the question of the obviousness of the claimed invention in view of the prior art relied upon, the Examiner is expected to make the factual determination set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. See also In re Rouffet, 149 F.3d 1350, 1355, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998). This

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evidence is required in order to establish a prima facie case. In re Piasecki, 745 F.2d 1468, 1471-72, 223 USPQ 785, 787-88 (Fed. Cir. 1984); In re Cofer, 354 F.2d 664, 668, 148 USPQ 268, 271-72 (CCPA 1966).

Upon a review of Xu and Narayen, consistent with the analysis made by Appellants, we find that the digital camera of Xu is accessed by a host computer only after initiating a software program for installing the camera as a disk drive (col. 4, lines 31-38). Additionally, the file directory for accessing the images on the camera is in the computer as a part of memory 91 and not within the camera (col. 4, lines 22-31). Narayen on the other hand, converts digital images, which are loaded onto the computer from the digital camera (col. 4, lines 10-15), into the web-viewable format to be electronically distributed or published in an album (col. 8, lines 40-45).

Contrary to the Examiner's assertion that Narayen generates an Internet description file in the image capture device (answer, page 9), there is no description file generated in the camera of Narayen that references the stored images. What the Examiner characterizes in Figures 1 and 5 of Narayen as the claimed generating a description file in the camera is in fact performed on the host computer (col. 1, lines 54-65 and col. 8, lines

7-42). Steps 10 and 225 of Narayen relate to acquiring an image from a digital camera and saving it in the computer memory while steps 12 and 229 relate to creating HTML or web-viewable format files for inserting the acquired images from the camera, which are all done on the host computer. The Examiner is correct to point out that the Web authoring software in Narayen is not device/camera specific (answer, page 9), but is incorrect to find that the files are generated on the image capture device or the camera whereas they are, indeed, created on the host computer.

We find ourselves in agreement with Appellants that while Xu teaches a camera that appears to the host computer as a disk drive by installing a software, Xu does so by generating a description or directory file on the computer and not within the camera. However, although we agree with Appellants (brief, page 8) that the computer of Xu does not communicate with the camera to acquire the images without the software, we note that only the claimed step of opening the Internet page description file in the image capture device or the digital camera for displaying the images on the computer requires doing so without the need for loading any camera-specific software. The step of or the means for generating an Internet page description file in the image



capture device, as recited in claims 1 and 8, does not specify whether any software is needed, but requires generating the description file in the camera. Narayen, on the other hand, does provide non-camera-specific and web-viewable format images for display, but as pointed out by Appellants (brief, page 11), they are generated on the host computer after the images are acquired by the host computer without the need for accessing the digital camera as a disk. Thus, assuming, arguendo, that it would have been obvious to combine Narayen with Xu, as held by the Examiner, the Internet page description file would not be on the image capture device since the HTML files of Narayen are in the host computer. Therefore, the combination would fall short of teaching the step of generating an Internet description file in the image capture device. Accordingly, as the Examiner has failed to set forth a prima facie case of obviousness, we do not sustain the 35 U.S.C. § 103 rejection of claims 1, 8, 11 and 12 over Xu and Narayen.

Claim 13, on the other hand, does not require that the HTML reference files be generated in the camera and merely recites that the images stored in the camera be displayed on the host computer through a web browser without the need for loading

camera-specific software. While Xu requires a software program to communicate with the camera to acquire the images, Narayen, as discussed above, provides non-camera-specific and web-viewable format images for display by creating HTML or web-viewable format files for inserting the acquired images from the camera.

Therefore, consistent with In re Etter, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985), we interpret the limitation of "generating an HTML file that references the images stored in the digital camera" as broadly as possible, consistent with the specification and without reading limitations appearing in the specification into the claims, and note that the generated HTML file is not precluded from being generated in the host computer. Therefore, the 35 U.S.C. § 103 rejection of claim 13 over the combination of the Xu and Narayen is sustained.

With respect to the rejection of claims 2-7, 9, 10 and 14-20, the Examiner further relies on Cohen for teaching the step of providing Java files along with the Internet page description files (answer, page 5) and on Wang for teaching the step of copying of the image files (answer, page 7). However, neither Cohen nor Wang provides any teaching related to the claimed generating the Internet page description file on the image

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capture device and fails to overcome the deficiencies of Xu and Narayen with respect to the independent claims as discussed above. Therefore, the 35 U.S.C. § 103 rejection of claims 2-7, 9 and 10 cannot be sustained. However, the 35 U.S.C. § 103 rejections of claims 14-18 over Xu, Narayen and Cohen and of claims 19 and 20 over Xu, Narayen and Wang are sustained since Appellants have not challenged these rejections with any reasonable specificity, thereby allowing claims 14-20 to fall with claim 13 (see In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987)).


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## CONCLUSION

In view of the foregoing, the decision of the Examiner rejecting claims 1-12 under 35 U.S.C. § 103 is reversed, but is affirmed with respect to the 35 U.S.C. § 103 rejection of claims 13-20.

AFFIRMED-IN-PART

  
KENNETH W. HAIRSTON  
Administrative Patent Judge

  
STUART S. LEVY  
Administrative Patent Judge

*MAHSHID D. SAADAT*  
MAHSHID D. SAADAT  
Administrative Patent Judge

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